



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,501	12/05/2003	John A. Wozniak	200314345-1	1952
22879      7590      05/18/2009 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400				
EXAMINER				
BOATING, ALEXIS ASIEDU'A				
ART UNIT		PAPER NUMBER		
2838				
NOTIFICATION DATE		DELIVERY MODE		
05/18/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM

ipa.mail@hp.com

jessica.l.fusek@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* JOHN A. WOZNIAK

---

Appeal 2009-0801  
Application 10/729,501  
Technology Center 2800

---

Decided:<sup>1</sup> May 14, 2009

---

Before KENNETH W. HAIRSTON, ROBERT E. NAPPI, and CARLA M. KRIVAK, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 6(b) of the rejection of claims 1 through 38.

We affirm-in-part.

---

<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## INVENTION

The invention is directed toward a battery pack with a protection circuit that can determine excessive current consumption of electrical components on the battery pack. See page 1 of Appellant's Specification. Claims 1 and 15 are reproduced below:

1. A battery pack, comprising:  
a protection circuit adapted to detect an excessive current consumption condition associated with electronic components forming the battery pack.

15. A battery pack, comprising:  
a battery core pack coupled to electronic components forming the battery pack; and  
an integrated circuit adapted to compare potentials across at least two different current sensors to detect an excessive current consumption condition associated with the electronic components.

## REFERENCES

Cheon	US 5,963,019	Oct. 5, 1999
Demuro	US 6,046,575	Apr. 4, 2000
Okutoh	US 6,060,185	May 9, 2000
Fujiwara	US 6,501,248 B2	Dec. 31, 2002
Sacki	US 6,492,791 B1	Dec. 10, 2002
Shirakawa	US 6,534,953 B3	Mar. 18, 2003 (filed Feb. 6, 2001)
Huelss	US 2003/0080747	May 1, 2003 (filed Dec. 3, 2001)

Okada	US 2003/0117143 A1	Jun. 26, 2003 (filed Dec. 20, 2002)
O’Conner	US 2004/0062387 A1	Apr. 1, 2004 (filed Dec. 13, 2001)

### REJECTIONS AT ISSUE

1) The Examiner has rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by Okutoh. The Examiner’s rejection is on pages 3 and 4 of the Answer.<sup>2</sup>

2) The Examiner has rejected claims 10, 11, 13, 14, 30, and 31 under 35 U.S.C. § 102(a) as being anticipated by Fujiwara. The Examiner’s rejection is on pages 4 and 5 of the Answer.

3) The Examiner has rejected claim 15 under 35 U.S.C. § 102(b) as being anticipated by Shirakawa. The Examiner’s rejection is on page 5 of the Answer.

4) The Examiner has rejected claims 2, 4, 5, and 9 under 35 U.S.C. § 103(a) as being unpatentable over Okutoh in view of Fujiwara. The Examiner’s rejection is on page 6 of the Answer.

5) The Examiner has rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Okutoh in view of Shirakawa. The Examiner’s rejection is on pages 6 and 7 of the Answer.

---

<sup>2</sup> Throughout the opinion we refer to the Answer mailed September 24, 2007.

6) The Examiner has rejected claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Okutoh in view of Cheon. The Examiner's rejection is on page 7 of the Answer.

7) The Examiner has rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Okutoh in view of O'Connor. The Examiner's rejection is on pages 7 and 8 of the Answer.

8) The Examiner has rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Fujiwara in view of Shirakawa. The Examiner's rejection is on pages 8 and 9 of the Answer.

9) The Examiner has rejected claims 16, 24, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Fujiwara in view of Shirakawa. The Examiner's rejection is on pages 9 and 10 of the Answer.

10) The Examiner has rejected claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Shirakawa in view of Demuro. The Examiner's rejection is on page 10 of the Answer.

11) The Examiner has rejected claims 22, 33, and 38 under 35 U.S.C. § 103(a) as being unpatentable over Shirakawa in view of Fujiwara, and Huelss. The Examiner's rejection is on pages 10 and 11 of the Answer.

12) The Examiner has rejected claims 21, 23, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Shirakawa in view of Fujiwara, and Okada. The Examiner's rejection is on page 11 of the Answer.

13) The Examiner has rejected claims 26, 28, 29, 35, and 37 under 35 U.S.C. § 103(a) as being unpatentable over Shirakawa in view of Fujiwara, and Cheon. The Examiner's rejection is on page 12 of the Answer.

14) The Examiner has rejected claims 27 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Shirakawa in view of Fujiwara, and Saeki. The Examiner's rejection is on page 13 of the Answer.

15) The Examiner has rejected claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Fujiwara in view of Shirakawa. The Examiner's rejection is on pages 13 and 14 of the Answer.

16) The Examiner has rejected claims 19 and 20 under 35 U.S.C. § 102(a) as being anticipated by Shirakawa. The Examiner's rejection is on page 14 of the Answer.

*Rejection of claim 1*

ISSUE

Appellant argues on pages 6 through 8 of the Brief<sup>3</sup> and page 4 of the Reply Brief that the Examiner's rejection of claim 1 under 35 U.S.C. § 102(b) is in error. Appellant argues that Okutoh teaches a system that detects current associated with the load external to the battery and not currents associated with the components forming the battery pack. Brief 8. Further, Appellant asserts that the Examiner erroneously equates "sensing current" with "consumption of current." Reply Brief 4.

Thus, Appellant's contentions present us with the issue: has Appellant shown that the Examiner erred in finding that Okutoh teaches that the protection circuit detects an excessive current consumption condition

---

<sup>3</sup> Throughout the opinion we refer to the Brief dated June 13, 2006, and Reply Brief, dated November 26, 2007.

associated with electronic components forming the battery pack as recited in claim 1?

### PRINCIPLES OF LAW

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Appl. Dig. Data Sys., Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984); *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983).

### FINDINGS OF FACT

1. Okutoh teaches a protective device for a battery which monitors voltage and overcharge. Abstract.
2. Okutoh teaches that the device also includes an overcurrent protecting device (item 13 in Figure 1). The overcurrent device monitors current by measuring the voltage drop across switching items 7 and 8. The current monitored is referred to as load current. See col. 3, ll. 38-45.
3. Okutoh does not appear to disclose where in the circuit the various circuit elements depicted in Figure 1 draw current. Rather, Figure 1 appears to merely show the nodes at which various voltages are measured.

### ANALYSIS

Appellant has persuaded us the Examiner erred in finding that Okutoh teaches the protection circuit detects excessive current consumption

condition associated with electronic components forming the battery pack as claimed. Claim 1 recites detecting current consumed by components forming the battery pack. The Examiner's rejection of claim 1 relies upon Okutoh's teaching of overcurrent monitoring to teach this limitation.

Answer 3-4. Further, in supporting this finding, the Examiner states "[a]ny current 'associated' with the load is associated with the components since all the current through the load is derived from that through components."

Answer 16. While we agree with the general proposition that when a battery provides power to circuits of a load and a monitoring circuit, the current through the battery will include both the current consumed by the load and the monitoring circuit. However, the Examiner has not shown that this is the case with Okutoh. Initially, we note that Okutoh identifies that the current monitored by the voltage drop across transistors 7 and 8 is associated with the load and makes no mention of a component of the current being associated with the monitoring circuit. Fact 2. Further, Okutoh does not teach where the monitoring circuits associated with the battery pack (shown in Figure 1) draw current. Fact 3. Thus, it is unclear whether the current monitored is the current through the battery (i.e., includes current consumed by the monitoring circuits associated with the battery pack and the load).<sup>4</sup> As such we do not find that the Examiner has shown that Okutoh teaches the

---

<sup>4</sup> From Figure 1, it is clear that items 13 and 2 are connected to terminals of the battery. From the narrative in column 3 lines 25-45 it appears that these connections are to measure voltage (i.e., high impedance inputs), thus the current source for these circuits is not known. However, if these connections also provided current to power the circuits, such current would not be monitored as such current does not flow through switches 7 and 8.



claim 1 limitation of detecting excessive current consumption associated with components forming the battery pack.

*Rejection of claims 10, 11, 13 and 14*

ISSUE

Appellant argues on pages 9 through 10 of the Brief and page 5 of the Reply Brief that the Examiner's rejection of representative claim 10 under 35 U.S.C. § 102(a) is in error. Appellant argues that Fujiwara teaches a system that detects current associated with a battery and not currents associated with the components forming the battery pack. Brief 9.

Thus, Appellant's contentions present us with the issue: has Appellant shown that the Examiner erred in finding that Fujiwara teaches a means to detect an excessive current consumption condition associated with electronic components forming the battery pack as recited in claim 10?

FINDINGS OF FACT

4. Fujiwara teaches a battery protection apparatus which monitors charge and discharge currents. The Apparatus is mounted in the battery pack (Figure 1, item 10). Abstract.
5. Fujiwara teaches that current flowing into the battery (charge current in direction A) and flowing from the battery (discharge current in direction B) is monitored by measuring the voltages at V- and Vss. As is apparent from Figure 1 the differences between voltage V- and Vss is caused by current flowing through transistors Q1 and Q2. Figure 1, col.7, ll. 35-50.
6. The circuit to monitor charge state and discharge state overcurrent is shown in Figure 2. Col. 7, l. 58 – col. 8, l. 6.
7. One skilled in the art viewing Figure 2, would recognize the circuit

elements draw a current which flows from Vdd to Vss and V-.

Thus, in the charging condition, the charging current A branches into two circuits, the first is through the battery (item 30), and the second is through the circuits shown in Figure 2.

### ANALYSIS

Appellant's arguments have not persuaded us of error in the Examiner's rejection of representative claim 10. Claim 10 recites a "means for detecting an excessive current consumption condition associated with the electronic components" forming the battery pack. Appellant has identified this as circuit item 12. Brief 3. Appellant's Specification on page 3, paragraph 0012 identifies item 12 as a circuit that includes elements which monitor current by measuring the voltage across sensors. We note that claim 10 does not recite that the only current detected is excessive current consumption associated with the electrical components. Thus, any teaching of detecting current in which the current includes excessive current consumption associated with electrical components of the pack will meet the claim.

In rejecting claim 10, the Examiner relies upon Fujiwara's teaching of monitoring excessive charging current as teaching detecting excessive current through the battery pack and the electrical components. Answer 16. We concur with the Examiner's analysis. Fujiwara teaches that current is monitored in both charging (direction A) and discharging (direction B). Fact 5. When charging current is flowing into the battery pack in direction A, this current is presented with two paths - through the battery or through the detection circuitry (i.e., current A is consumed by two components - battery and protection circuitry). Fact 7. Thus, we find that Fujiwara's circuit does

detect the current consumed by the electronics associated with the electronic components within the battery pack. Further, as Fujiwara teaches that the circuit accomplishes this by monitoring the voltage across two transistors Q1 and Q2 (Fact 5), we consider the circuit to be an equivalent to the circuit in Appellant's Specification claimed as the "means for detecting." Thus, Appellant has not persuaded us that the Examiner erred by finding that Fujiwara teaches a means to detect excessive current consumption condition associated with electronic components forming the battery pack as recited in claim 10. Accordingly, we sustain the Examiner's rejection of claim 10 and claims 11, 13, and 14 which Appellant has grouped with claim 10.

*Rejection of claims 30 and 31*

ISSUE

Appellant argues on pages 10 through 12 of the Brief and page 6 of the Reply Brief that the Examiner's rejection of representative claim 30 under 35 U.S.C. § 102(a) is in error. Appellant argues that Fujiwara teaches a system that detects current associated with a battery and does not teach a system which can distinguish between current consumption associated with the components forming the battery pack and current flow associated with the host device. Brief 8.

Thus, Appellant's contentions present us with the issue: has Appellant shown that the Examiner erred in finding that Fujiwara teaches a protection circuit to distinguish excessive current consumption condition associated with electronic components forming the battery pack from current flow associated with the host device as recited in claim 30?

## ANALYSIS

Appellant's arguments have persuaded us of error in the Examiner's rejection of representative claim 30. Claim 30 recites a protection circuit to distinguish between current consumption associated with electronic components coupled to the battery pack and current flow associated with the host device. Thus, claim 30 differs from claims 1 and 10, discussed above, in that the circuit of claim 30 requires that the circuit distinguish current consumption, i.e., separately identify the current consumption by components of the battery pack from other items that consume current, i.e., the host load.

In rejecting claim 30, the Examiner relies upon Fujiwara's teaching of monitoring excessive charging current of the battery pack. Answer 16-17. While, as discussed above with respect to claim 10, we find that Fujiwara's teaching of monitoring battery charging current includes a teaching that the current consumed by the circuits is detected, we do not find that the currents are separately identified (distinguished). Thus, Appellant has persuaded us that the Examiner erred in finding that Fujiwara teaches a protection circuit to distinguish excessive current consumption condition associated with electronic components forming the battery pack from current flow associated with the host device as recited in claim 30. Claim 31 is dependent upon claim 30. Accordingly, we will not sustain the Examiner's rejection of claims 30 and 31.

*Rejections of claims 32-38*

ANALYSIS

Claims 32 through 38 all depend upon claim 30. The Examiner has rejected these claims under 35 U.S.C. § 103(a) based upon Fujiwara in combination with Shirakawa, Huelss, Okada, Cheon, and Saeki. The Examiner has not found, nor do we find, that the additional teachings of these references teach a protection circuit to distinguish excessive current consumption condition associated with electronic components forming the battery pack from current flow associated with the host device (i.e., the Examiner has not found that the references include a teaching which makes up for the deficiency noted in the rejection of dependent claim 30). Accordingly, we will not sustain the Examiner's various rejections, under 35 U.S.C. § 103(a), of claims 32 through 38 for the reasons discussed with respect to claim 30.

*Rejection of claims 15, 19, and 20*

ISSUE

Appellant argues on pages 12 through 14 of the Brief and page 7 of the Reply Brief that the Examiner's rejection of claim 15 under 35 U.S.C. § 102(b) is in error. Appellant argues that Shirakawa teaches a system that detects current associated with the battery and not currents associated with the electronic components forming the battery pack. Brief 12. Further, Appellant asserts that the Examiner erroneously equates "sensing current" with "consumption of current." Reply Brief 7.

Thus, Appellant's contentions present us with the issue: has Appellant shown that the Examiner erred in finding that Shirakawa teaches a circuit to

detect an excessive current consumption condition associated with electronic components forming the battery pack as recited in claim 15?

#### FINDINGS OF FACT

8. Shirakawa teaches a system to reduce the charging time required for charging a battery pack. Abstract.
9. The battery pack used in Shirakawa's system includes a circuit (item 70) which controls the charging and discharge of the battery cell (item 60). Col. 4, ll. 43-51.
10. The control circuit makes use of two sensing resistors R74 and R75 to sense and control the charge current of the battery. Shirakawa, col. 5, ll. 25-33.
11. Shirakawa does not appear to disclose where in the circuit the elements of the various circuit elements depicted in Figure 2 draw current. Rather, Figure 2 appears to merely show the nodes at which various voltages are measured and nodes by which the circuit elements are controlled.

#### ANALYSIS

Appellant's arguments have persuaded us of error in the Examiner's rejection of claim 15. Claim 15 recites a "circuit adapted to compare potentials across at least two different current sensors to detect an excessive current consumption condition associated with the electrical components" of the battery pack. Thus, as with claims 1 and 10, claim 15 recites detecting an excessive current consumption condition associated with the electrical components of the battery pack, but does not recite that the only current detected is excessive current consumption associated with the electrical components. Thus, any teaching where excessive current consumption is

associated with electrical components of the pack will meet the claim, even if the detected current includes currents consumed by other components.

In rejecting claim 15, the Examiner relies upon the same reasoning discussed above with respect to claim 1 that the current sensed from the battery pack is current that is associated with the electronic components because the battery pack is coupled to these components. We disagree with the Examiner's rationale, however, our reasons are different than those discussed with respect to claim 1. We note that Shirakawa teaches that current is monitored by resistors R74 and R75, but makes no mention of a component of the current being associated with the monitoring circuit. Fact 9. Further, Shirakawa does not teach where the monitoring circuits associated with the battery pack (shown in Figure 2) draw current. Fact 11. Claim 15 recites that the determination of current consumption of electronic components is made by a circuit that compares potentials across two different current sensors. Thus, while we agree with the Examiner's finding that Shirakawa teaches use of two current sense resistors (Fact 9), we do not find that Shirakawa teaches comparing the potentials to determine a current that is consumed by electronic components forming the battery pack. As such, we are persuaded by Appellant's arguments that the Examiner erred in finding that Shirakawa teaches a circuit to detect an excessive current consumption condition associated with electronic components forming the battery pack as recited in claim 15. Claims 19 and 20 are dependent upon claim 15; accordingly, we will not sustain the Examiner's rejection for the same reasons.

*Rejection of claims 2, 4, 5, and 9; new rejection of claim 1*

ISSUE

Appellant argues on page 14 of the Brief that the Examiner's rejection of claims 2, 4, 5, and 9 under 35 U.S.C. § 103(a) as being unpatentable over Okutoh in view of Fujiwara is in error. Appellant argues that these claims depend upon claim 1 and are allowable for the same reasons as claim 1. Specifically, Appellant argues that Okutoh does not teach or suggest "a protection circuit adapted to detect an excessive current consumption condition associated with electronic components forming the battery pack."

Thus, Appellant's contentions present us with the issue: has Appellant shown that the Examiner erred in finding that the combination of Okutoh in view of Fujiwara teaches that the protection circuit detects an excessive current consumption condition associated with electronic components forming the battery pack as recited in claims 1, 2, 4, 5, and 9?

ANALYSIS

Appellant's arguments have not persuaded us of error in the rejection of claims 2, 4, 5, and 9, and we now reject claim 1 applying the Examiner's rationale. As discussed above, with respect to claim 1, we agree with Appellant's argument that Okutoh does not teach the claim limitation directed to detecting an excessive current consumption associated with components of the battery pack. However, as discussed above with respect to claim 11, we do find ample evidence of record to support the Examiner's finding that Fujiwara does teach this limitation. As the only issue before us with respect to claims 2, 4, 5, and 9 is directed to a limitation which is found in Fujiwara, we sustain the Examiner's rejection of claims 2, 4, 5, and 9 and



we similarly apply the rejection this rejection to independent claim 1 which recites the limitation.

*Rejection of claims 3 and 6 through 8.*

ISSUE

Appellant argues on pages 14 and 15 of the Brief that the Examiner's rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Okutoh in view of Shirakawa is in error. Similarly, Appellant argues that the Examiner's rejection of claims 6 and 7 as being unpatentable over Okutoh in view of Cheon and the Examiner's rejection of claim 8 under Okutoh in view of O'Connor are in error. Appellant's rational in support of these arguments is that these claims depend upon claim 1 and are allowable for the same reasons as claim 1.

Thus, Appellant's argument with respect to claim 3 presents us with the same issue as discussed above with respect to claim 1.

ANALYSIS

As discussed above, Appellant's arguments directed to the rejection of claim 1 have persuaded us that the Examiner erred in rejecting claim 1 as being anticipated by Okutoh. Claims 3 and 6 through 8 are dependent upon claim 1 and in rejecting these claims the Examiner relied upon Okutoh to teach the limitations of claim 1. Thus, we will not sustain the Examiner's rejections of these claims as being unpatentable over the combination of Okutoh with the teachings of Shirakawa, Cheon, or O'Connor. We note, that while claim 1 is subject to a new rejection under 35 U.S.C. § 103(a) as being unpatentable over Okutoh in view of Fujiwara, we do not apply a new rejection against these claims based on Okutoh in view of Fujiwara and the

additional references. Rather, we leave it to the Examiner to determine whether such a combination would have been obvious.

*Rejection of claim 12.*

ISSUE

Appellant argues on pages 15 through 18 of the Brief that the Examiner's rejection of claim 12 is in error. Appellant asserts that claim 12 is dependent upon claim 10 and is allowable for the reasons discussed with respect to claim 10. Further, Appellant argues that Shirakawa does not teach the claim 12 limitation of "comparing a voltage potential across at least two different current sensors to detect the excessive current consumption condition." Appellant's argument to support this assertion applies the same logic as presented with respect to the rejection of claim 15 based upon Shirakawa.

Thus, Appellant's contentions present us with the same issue raised with respect to claim 10, and the same issue raised with respect to claim 15.

ANALYSIS

Appellant's arguments have persuaded us of error in the Examiner's rejection of claim 12. Claim 12 is dependent upon claim 10 and contains a limitation directed to determining current consumed by components of the battery pack by comparing potential across two current sensors. This limitation is similar to the one recited in claim 15. As discussed above Appellant's arguments directed to the rejection of claim 10 have not persuaded us of error in the rejection of claim 15. However, as discussed above with respect to claim 15, Appellant's arguments have persuaded us that the Examiner erred in finding that Shirakawa teaches comparing the

voltage potential across two different current sensors to detect excessive current. Thus, we will not sustain the Examiner's rejection of claim 12.

*Rejection of claims 16 through 29.*

ISSUE

Appellant argues on pages 17 through 21 of the Brief that the Examiner's rejections of claims 16 through 29 under 35 U.S.C. § 103(a) as being unpatentable over Shirakawa in combination with other references are in error. Appellant argues that these claims depend upon claim 15 and are allowable for the same reasons as claim 15.

Thus, Appellant's argument with respect to claims 16 through 29 presents us with the same issue as discussed above with respect to claim 15.

ANALYSIS

As discussed above, Appellant's arguments directed to the rejection of claim 15 have persuaded us that the Examiner erred in rejecting claim 15 as being anticipated by Shirakawa. Claims 16 through 29 are dependent upon claim 15 and in rejecting claims 16 through 29 the Examiner relied upon Shirakawa to teach the claim 15 limitations of comparing the voltage potential across two different current sensors to detect excessive current. Further, the Examiner has not found that the additional references cited in various rejections of claims 16 through 29 teach this limitation. Thus, we will not sustain the Examiner's rejections of claims 16 through 29 under 35 U.S.C. § 103(a) as the Examiner has not shown that the prior art teaches the limitation of comparing the voltage potential across two different current sensors to detect excessive current as recited in independent claim 15.

### CONCLUSION

Appellant has not persuaded us of error in the Examiner's rejection of claims 10, 11, 13, and 14 under 35 U.S.C. § 102(a). Nor has Appellant convinced us of error in the Examiner's rejection of claims 2 through 5, 9, and 12 under 35 U.S.C. § 103(a). However, Appellant's arguments have persuaded us of error in the Examiner's rejections of claims 1, 15, 19, and 20 under 35 U.S.C. § 102(b) and the Examiner's rejections of claims 6 through 8, and 16 through 38 under 35 U.S.C. § 103(a). We enter a new rejection against claim 1 under 35 U.S.C. § 103(a).

### ORDER

The decision of the Examiner to reject claims 1 through 38 is affirmed-in-part.

We enter a new rejection of claim 1 under 35 U.S.C. § 103.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). This section provides that "[a] new ground of rejection... shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

Appeal 2009-0801  
Application 10/729,501

(2) Request that the proceeding be reheard  
under § 41.52 by the Board upon the same  
record. . . .

No time period for taking any subsequent action in connection with  
this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART  
37 C.F.R. 41.50(b)

ELD

HEWLETT PACKARD COMPANY  
P O BOX 272400, 3404 E. HARMONY ROAD  
INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400